

## REMARKS/ARGUMENTS

### I. NON-PRIOR ART MATTERS.

- A. The Office Action noted that certain references were not considered because a concise explanation of the relevance and/or a complete copy was not presented.

Applicant is submitting herewith a Supplementary Information Disclosure Statement with complete English language translations of all non-English language references, thereby eliminating the need for a concise statement of relevance. 37 CFR 1.98(a)(3)(ii), MPEP 609(III)A(3) (“if a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required”).

- B. The Office Action rejected claims 3 and 13 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims have been amended as suggested.

Claims need only “reasonably apprise those skilled in the art” for their scope and be “as precise as the subject matter permits.”<sup>1</sup> The test of definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more.<sup>2</sup>

A claim need not describe the invention, such description being provided by the specification’s disclosure section.<sup>3</sup>

The claim, in light of the specification, is not indefinite or incomplete.

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<sup>1</sup> *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81 (Fed. Cir. 1986)

<sup>2</sup> *id.*

<sup>3</sup> *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986)

II. PRIOR ART MATTERS.

- C. The Office Action rejected claims 1, 4, and 8 under 35 USC 102(ae as being anticipated by Slemker Applicant respectfully traverses this rejection.

A single prior art reference anticipates a claimed invention only if it discloses each and every claim element.<sup>4</sup>

Slemker does not disclose: a valveless plate/socket attachment for connecting the vacuum source to the socket cavity. Applicant discussed Slemker at page 22, last paragraph and distinctly pointed out that all embodiments of Slemker require some sort of valve associated with the plate. Applicant's invention involves a valveless plate/socket attachment.

Claim 1 is therefore allowable.

Claims 4 and 8 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

- D. The Office Action rejected claims 9 and 10 under 35 USC 103(a) as being unpatentable over Slemker. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.<sup>5</sup> If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.<sup>6</sup>

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

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<sup>4</sup> *Structural Rubber Prod. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984)

<sup>5</sup> MPEP Sec. 2142.

<sup>6</sup> *Id.*

expectation of success must both be found in the prior art, and not based on applicant's disclosure.<sup>7</sup>

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

The reference does not teach or suggest all the claim limitations, as discussed above in regard to claim 1.

Claims 9 and 10 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

In addition, the Examiner is taking Official Notice that:

Regarding claim 10, a weight-actuated vacuum pump was well known and would have been obvious in order to avoid the need for external power altogether....

This is impermissible. As noted above, the prior art “must teach or suggest all the claim-limitations.” The Examiner has not shown where the prior art teaches or suggests a weight-actuated vacuum pump.

Finally, the Examiner has not applied the test of *Graham v. John Deere Co.*<sup>8</sup> The MPEP requires the Examiner to do so.<sup>9</sup> However, the Examiner has made no finding of the level of ordinary skill in the art.<sup>10</sup>

E. The Office Action rejected claim 7 under 35 USC 103(a) as being unpatentable over Slemker in view of Fishman. Applicant respectfully traverses the rejection.

Claim 7 contains additional elements or limitations beyond allowable claim 1 and is also allowable.

F. The Office Action rejected claims 3, 5, 6, and 11 under 35 USC 103(a) as being unpatentable over Slemker in view of Caspers. Applicant respectfully traverses the rejection.

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<sup>7</sup>Id. (emphasis supplied)

<sup>8</sup> 383 U.S. 1 (1966)

<sup>9</sup> MPEP § 2141

<sup>10</sup> MPEP § 2141.03

Claims 3, 5, 6, and 11 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

G. The Office Action objected to claims 2 and 12 as being dependent upon a rejected base claim.

Claims 2 and 12 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

H. The Office Action indicated that claim 13 would be allowable if rewritten to overcome the rejection under 35 USC 12, second paragraph and to include the limitations of the base claim and any intervening claims Applicant respectfully traverses the rejection.


Claim 13 has been amended to overcome the 35 USC 112, second paragraph rejection. Claim 13 contains additional elements or limitations beyond allowable claim 1 and is also allowable.

Applicant thanks the Examiner for indicating that claims 14 and 15 are allowable.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Respectfully submitted,

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